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[REDACTED] EXAMINER

PAK, JOHN D

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1616

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/692,797</b>	Applicant(s) <b>MASON</b>
	Examiner <b>John Pak</b>	Art Unit <b>1616</b>
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
<b>Period for Reply</b> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Feb 10, 2003</u></p> <p>2a) <input checked="" type="checkbox"/> This action is FINAL.      2b) <input type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<b>Disposition of Claims</b> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-22</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) <u>4, 8, 9, and 18</u> is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-3, 5-7, 10, 11, 13-17, and 19-22</u> is/are rejected.</p> <p>7) <input checked="" type="checkbox"/> Claim(s) <u>2, 12, and 14</u> is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:  1. <input type="checkbox"/> Certified copies of the priority documents have been received.  2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.  3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>*See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b> <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p>		

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Claims 1-22 are pending in this application. Applicant is advised that the term “glyphosate” will be used in this Office Action as a shorthand reference to N-(phosphonomethyl)glycine and its salts.

Claims 4, 8 and 9 stand withdrawn as being directed to non-elected subject matter. New claim 18 is also withdrawn as being directed to non-elected subject matter.

Claims 2 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 2 and 14 depend from independent claims that require both glyphosate and fatty acid-based active ingredient. Claims 2 and 4 recite “wherein the composition comprises the isopropyl amine salt of N-(phosphonomethyl)glycine.” This is problematic because such language can imply no fatty acid-based active ingredient being present. The Examiner suggests something like “wherein the N-(phosphonomethyl)glycine salt is isopropyl amine salt of N-(phosphonomethyl)glycine.”

New claims 13-17 and 19-22 are rejected under 35 USC 112, first paragraph, as based on a disclosure that is not enabling. The claims read on the fatty acid-based active ingredient being higher than 3 wt% of a ready-to-use composition. However, the specification clearly discloses that fatty acid-based active ingredient is to be present at a concentration below what is recommended for its individual (used alone) herbicidal

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activity. See for example specification page 4, first paragraph. Applicant explicitly states that concentration range of 3-6% is “ordinarily necessary to achieve herbicidal activity” in the case of fatty acid-based active ingredients (specification page 10, lines 9-10). This means the fatty acid-based active ingredient must be in a concentration range that does not exceed 3% of a ready-to-use composition. Therefore, use of fatty acid-based active ingredient at a concentration range that does not exceed 3 wt% of a ready-to-use composition is critical or essential to the practice of the invention, but such feature is not included in the claims. See In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Applicant’s arguments relative hereto (made with respect to previously pending claims), filed in Paper No. 14 (2/10/03) have been given due consideration, but they were deemed unpersuasive. Applicant asserts that specification page 9 line 26 to page 10, line 5 supports applicant’s position that the concentration feature discussed above is not critical to the invention. However, applicant’s arguments are misdirected, as the present ground of rejection is focused on the concentration amount of fatty acid-based active ingredient. Applicant’s arguments are not directed to concentration amount of fatty acid-based active ingredient. Applicant’s noted specification section supports the Examiner’s position that an upper concentration limit is required in the claims for the fatty acid-based active ingredient.

New claims 13-17 and 19-22 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As noted above, the claims here read on the fatty acid-based active ingredient being higher than 3 wt% of a ready-to-use composition. However, the specification clearly discloses that each active ingredient, i.e. glyphosate and fatty acid-based active ingredient, is present at a concentration below what is recommended for herbicidal activity of each ingredient alone. See for example specification page 4, first paragraph. Applicant explicitly states that concentration range of 3-6% is “ordinarily necessary to achieve herbicidal activity” in the case of fatty acid-based active ingredients (specification page 10, lines 9-10). This means the originally filed disclosure requires fatty acid-based active ingredient to have a concentration range that does not exceed 3% of a ready-to-use composition. Therefore, use of fatty acid-based active ingredient at a concentration range that is unrestricted, as in claims 13-17 and 19-22, was not reasonably conveyed by the originally filed disclosure; and the claims do not find adequate descriptive support from the originally filed disclosure.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3, 5-7, 10-11, 13-17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Wells, Franz, Franz and WO 89/03178 in view of Sampson and WO 90/07275 for the reasons fully set forth in Paper No. 10 (9/10/02), pages 4-6.

At the outset, it is noted that this ground of rejection does not apply to subject matter encompassed by claims 1-17 of U.S. Patent No. 5,196,044. This ground of rejection only applies to subject matter that is not encompassed by said claims of the 5,196,044 patent.

Applicant's remarks and amendments of Paper No. 14 (2/10/03) have been given due consideration, but they were deemed unpersuasive. Applicant argues that a prima facie case of obviousness has not been established. Nothing could be further from the facts of this case. Both glyphosate and fatty acid-based active ingredients are notoriously well known herbicides and both are known to be used with other herbicides. That alone should be sufficient motivation to combine the two to arrive at a third herbicide in order to obtain the advantages of both herbicides in one application. In re Sussman, 58 USPQ 262, 264-65 (CCPA 1943); see In re Kerkhoven, 205 USPQ 1069, 1072 (CCPA 1980).

Applicant argues that there is no motivation to combine glyphosate at 0.08-2 wt% and fatty acid-based active ingredient at 0.5-3 wt%. This argument is not at all persuasive. Applicant admits on specification page 10, lines 1-10 that at least the high end in both concentration ranges would have been expected to deliver adequate herbicidal activity. Additionally, WO 89/03178 explicitly discloses and suggests the fatty acid-based active ingredient concentration range that is well within the range claimed by applicant. At page 4, first paragraph of WO 89/03178, concentration of 0.5 wt% or

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higher is disclosed for fatty acids and their salts. Additional disclosures clearly suggest the fatty acid/salt concentration range of the instant claims. See in WO 89/03178, page 6, last paragraph to page 7, first paragraph.

Applicant argues that several of the cited references do not explicitly disclose the claimed invention. It is noted that this rejection is under section 103(a), not section 102. In all of applicant's arguments, applicant fails to take into account the fact that glyphosate and fatty acid/salt are two very well known herbicidal agents. It is common in the herbicidal art to take two herbicides and form a mixture. This is the <sup>ordinary</sup> level of skill in the herbicidal art. In fact, the U.S. patent classification system even has a series of subclasses in the early part of class 504 (class for herbicides) that is devoted strictly to herbicidal mixtures. That is how commonplace it is to combine known herbicides to deliver a mixture that has the advantages of several active agents and that is the level of ordinary skill and knowledge in this art. Taken with the established facts in this case that fatty acids are already known to be used in conjunction with glyphosate and such use is known to benefit efficacy, there would have been ample motivation for the ordinary skilled artisan in this art to have arrived at the invention as presently claimed.

With respect to applicant's data, it is noted again that they fall far short of being commensurate in scope with that of the claimed subject matter. The claims read on saponified or non-saponified fatty acid-based active ingredient present at 0.5-3 wt% of a ready-to-use composition. Various mixtures of fatty acid-based active ingredients are possible. However, applicant's data is limited for the most part to pelargonate, wherein

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the upper limit of the data is at 1 wt%<sup>1</sup>. Given the fact that there is an expectation of herbicidal result when two known herbicides are combined, it cannot be said that applicant's data is commensurate in scope with the claimed subject matter as a whole. While herbicidal activity is expected from the combinations that are encompassed by the claims, applicant's supposed assertion of better than expected activity must be supported by objective evidence. Since such activity is by definition "unexpected," applicant's attempt to have one data type (pelargonate) carry the probative weight of the entire claimed subject matter ("saponified or non-saponified fatty acid-based active ingredient") is not acceptable.

For these reasons the claims are again rejected under section 103(a).

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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<sup>1</sup> Specification Table 1 (p. 13) shows a 3-component mixture. Note, claims directed solely to this mixture are not included in this ground of rejection. Specification Table 4 (p. 17) is directed to non-elected subject matter. Remaining specification data and tables are directed to pelargonate only.

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600